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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/737,697
Filing Date: December 14, 2000
Appellant(s): SLAIGHT ET AL.

Jenni R. Moen
For Appellant

EXAMINER'S ANSWER

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This is in response to the BPAI's administrative remand to Examiner mailed on May 25, 2010.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

NEW GROUND(S) OF REJECTION

Claims 15-24 are rejected under 35 U.S.C. § 112, first paragraph, as not being enabled for the scope of the claim.

The claims are drafted in a means plus function format and recite only a single means: a computer readable storage medium.

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The claims are drawn only to a single element instead of a combination. The claims are directed to a system having a single element. A mere recital of a software stored on the computer readable storage medium and operable when executed does not constitute an additional element. Thus, every claim listed above is a single means claim.

A single means claim covers every conceivable means for achieving the stated result while the specification discloses at most only those means known to the inventor. See *O'Reilly v. Morse*, 56 U.S. 62, 112, 14 L. Ed. 601 (1853). The U.S. Court of Appeals for the Federal Circuit stated that such a claim is properly rejected based on the first of paragraph of 35 USC § 112, ¶ 1. *In re Hyatt*, 708 F.2d 712, 714-715 (Fed. Cir. 1983).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

7,249,085	Kinney et al.	07-2007
5,835,896	Fisher et al.	11-1998
5,402,336	Spiegelhoff et al.	03-1995
7,107,268	Zawadzki et al	09-2006
6,351,738	Clark	02-2002
7,107,268	Barns- Slavin et al	11-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3, 5-7, 10-12, 14-18, 20-22, 23-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Kinney, Jr. et al (US 7249085).

Re claims 5,15 and 25: Kinney teaches a method (and corresponding system and readable medium) of conducting an on-line auction, comprising: receiving bids from a plurality of vendors, each bid comprising a plurality of parameters associated with at least one product (col. 4, lines 16-36; col. 5, lines 19-33), calculating, using a computer, the total cost of the at least one product to a purchaser for each vendor in response to

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the vendors' bids, the total cost taking into account the plurality of parameters associated with the at least one product (col. 5, lines 50-53; col. 6, lines 6-13 “ ‘*x*’ representing price parameter and ‘*a*’ representing non-price parameter”; col. 7, lines 41-47), enabling a purchaser to make at least one adjustment corresponding to at least one of the vendor bids which is used by calculating means to determine the total cost of the product to the purchaser (col. 7, lines 32-34, col. 9, lines 30-34), and outputting, using the computer, each of the vendors bids and the total cost of the product to the purchaser (col. 6, lines 11-13, 24-27, “ ‘*y*’ refers to bid parameter resulting from the transformation process, upon which the buyer will compare competing bids” ; col. 7, line 57 through col. 8, line 3).

Re claims 2, 18 and 26: Kenney teaches defining a plurality of parameters for a category of products; and defining a total cost formula for the category of products in response to the plurality of parameters (col. 8, lines 4-55; “*BTU/lb, %sulfur, %ash*”, “*cost per unit of thermal content, cost per unit of electrical output*”).

Re claims 3, 16-17 and 27: Kinney teaches wherein the total cost formula includes at least one constant associated with at least one parameter (col. 5, lines 50-53; col. 6, lines 6-13; col. 9, lines 54-55, *parameter “x” representing price is constant*).

Re claim 28: Kinney teaches wherein the plurality of parameters includes price and non price parameters (col. 4, lines 16-36; col. 5, lines 19-33).

Re claim 29: Kinney teaches wherein the price parameters include at least one of a base price, volume discounts, rebates, life cycle discounts, utilization charges, maintenance charges and administration charges (col. 5, lines 50-53; col. 6, lines 6-13).

Re claims 12 and 30: Kinney teaches wherein the non-price parameters include at least one of delivery timing, national service coverage, minimum quality levels, employee skill levels, a dedicated account management team, special reporting requirements, online ordering, warranty and length of contract (col. 5, lines 19-33; col. 8, line 66 through col. 9, line 6, "*reputation of the supplier, etc*" and "*delivery time, etc*").

Re claim 31: Kinney teaches wherein defining a plurality of parameters comprises defining at least two sub-categories for the category of products, and defining at least two parameters for each subcategory (col. 8, lines 4-55).

Re claims 6-7, 14 and 32: Kinney teaches communicating the best vendor's bid to the other vendors to encourage competitive bidding (col. 9, lines 21-27).

Re claim 10: Kinney teaches means for setting up the bidding on the product (Fig. 1 and 4)

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Re claim 20: Kinney teaches wherein bids from vendors are received through an Internet (abstract, col. 3, lines 56-60).

Re claims 21-22: Kinney teaches providing a vendor or purchaser with data about the status of an auction while the auction is in progress (Figs. 6A-6C).

Re claim 24: Kinney teaches allowing a total cost formula to be defined for each product in an auction (col. 6, lines 6-23).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kinney.

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Re claim 19: Kinney does not explicitly teach wherein the auction results take into account vendors bid on a market basket of products. Official notice is hereby taken that this feature is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kinney to include this feature so that the purchaser can buy multiple products from the same vendor to take advantage of volume discount and/or shipping costs associated with purchasing individual items from various vendors.

Support for this official notice can be found in Barns-Slavin et al (US 5995950) at col. 1, lines 10-14; and Clark (US 6351738) at abstract.

Claims 4, 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinney in view of Fisher et al (US 5835896).

Re claims 4, 8 and 13: Kinney further teaches communicating a vendor total cost to the vendors and that the invention can be applied in the context of upward based auction (Figs. 6B and 6C; col. 5, lines 56-59). Kinney does not explicitly teach this feature without revealing the identification of the vendor; and enabling messages to be sent to the vendor regarding status of bidding, ending time for the bidding and extension of the bidding. Fisher, in the same field of art, teaches these concepts and features at Fig. 2, col. 6, lines 31-58. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kinney to include these features as taught by Fisher for the obvious reason of updating the vendors about the status of the bids.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kinney in view of Spiegelhoff et al (US 5402336).

Re claim 9: Kinney does not explicitly teach for calculating an amount of savings for the purchaser and means for communicating the savings to the purchaser. Spiegelhoff teaches this concept at col. 13, lines 33-36. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kinney to include this feature as taught by Spiegelhoff for the obvious reason of identifying the best bid in terms of savings.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kinney in view of Zawadzki et al (US 7107268).

Re claim 23: Kinney does not explicitly teach controlling which vendors are allowed to participate in an auction. Zawadzki teaches this concept at col. 53, lines 6-20. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kinney to include this feature as taught by Zawadzki for the obvious reason of restricting participant to the auction.

NEW GROUND(S) OF REJECTION

Claims 15-24 are rejected under 35 U.S.C. § 112, first paragraph, as not being enabled for the scope of the claim.

The claims are drafted in a means plus function format and recite only a single means: a computer readable storage medium.

The claims are drawn only to a single element instead of a combination. The claims are directed to a system having a single element. A mere recital of a software stored on the computer readable storage medium and operable when executed does not constitute an additional element. Thus, every claim listed above is a single means claim.

A single means claim covers every conceivable means for achieving the stated result while the specification discloses at most only those means known to the inventor. See *O'Reilly v. Morse*, 56 U.S. 62, 112, 14 L. Ed. 601 (1853). The U.S. Court of Appeals for the Federal Circuit stated that such a claim is properly rejected based on the first of paragraph of 35 USC § 112, ¶ 1. *In re Hyatt*, 708 F.2d 712, 714-715 (Fed. Cir. 1983).

(10) Response to Argument

A. Rejection of claims 2-3, 5-7, 10, 12, 14-18, 20-22 and 24-32 under 35 U.S.C. § 102(e) as being anticipated by Kinney.

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Applicant argues that Kinney does not teach “enabling a purchaser to make at least one adjustment corresponding to at least one of the vendor bids which is used by calculating means to determine the total cost of the product to the purchaser”. Examiner respectfully disagrees. Kinney explicitly teaches that the buyer can alter the supplier’s perception of the relative attractiveness of the submitted bid (col. 7, lines 32-35).

Examiner notes that by having the factors used in the transformation function confidential to the buyer (transformation function being subjectively determined by the buyer using weightings of the various parameters associated with supplier’s bid), the buyer inherently modifies or adjusts the supplier’s bid using the transformation function. This adjustment is automatically done to each and every bid via the transformation function.

B. Rejection of claims 4, 8 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Kinney in view of Fisher.

Appellant also argues that Fisher fails to disclose explicitly disclose the communicating a vendor bid “without revealing the identification of the vendor”. Examiner respectfully disagrees. Fisher teaches sending email notification to bidders who have been out-bid by the just-placed bid. Fisher further teaches that the message includes information regarding the product, the current high bid, bid increment, etc. Examiner notes that the name or identification of the bidder of the bidder is not required or necessary as part of the message as compared to when the bidder wants to place a bid (see col. 6, lines 31-38). Fisher explicitly teaches that the identification of the

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bidder, address, bid amount, payment information are necessary information to be provided when placing the bid.

The Fisher reference does not teach away from the limitation because the bidders in Fisher are broadly interpreted as either purchasers (forward auction format) or vendors (reverse auction format) (see abstract "variety of formats"). Examiner notes that the Fisher reference is reasonably pertinent to the particular problem with which the applicant was concerned.

Regarding claim 8, Appellant asserts that Fisher reference does not teach "ending time for the bid" and "extensions of the bidding". Fig. 2 of Fisher explicitly shows that auction closing time. Examiner interprets auction closing time as both the ending time and the extension of bidding. Also Examiner asserts that the extension of the bidding is reflected in the auction closing time.

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(11) Related Proceeding(s) Appendix

This appeal is related to Appeal No. 2007-4252 decided by the Board of Patent Appeals and Interference on March 26. There are no other known appeals, Interferences, or judicial proceedings that will directly affect or directly affected by or have a bearing on the Board's decision regarding this Appeal

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

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Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Olabode Akintola

Patent Examiner, AU 3691

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn Coggins/

Technology Center Director

TC 3600

Conferees:

/Hani M. Kazimi/

Primary Examiner, AU 3691

Vincent Millin/vm/

TC3600 Appeals Conference Specialist

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